



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,605	11/20/2001	Scott Montgomery	703602.6	3869

34313 7590 03/27/2007  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA  
SUITE 1600  
IRVINE, CA 92614-2558

EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/990,605

Applicant(s)

MONTGOMERY ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 157-161 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 157-161 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3621

### **DETAILED ACTION**

1. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 157-161 are considered.
- Claims 1-156 were canceled.
- Claims 157-158 are amended.
- Claims 159-161 are added.

### ***Response to Arguments***

2. Applicant's arguments filed October 18, 2007 have been fully considered with respect to claim 157, but are moot in view of the new ground(s) of rejection.

3. However, examiner would like to clarify few points as what the claims have explicitly disclosed and what the applicant has argued. The claim discloses specifically that "upon receiving the tracking identification string from the postal authority, the centralized postage-issuing (owned and operated by the postal services) computer retrieves and validates the unique indicium..." There is no indication or explicit negation of the issuing entity is different than the verifying entity. Additionally it is clearly disclosed by the claims as "a master tracking computer system," different than the "centralized postage-issuing computer system" is generating the unique ID string that is transmitted to the centralized postage-issuing computer (of the postal authority to be stored for further reference and authentication of the mail piece presentation.)

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3621

2. Claims 157 and 161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner has reviewed the specification to the extent that the examiner has been able to review the specification, the fact "the centralized postage-issuing system" not being part of the USPS or being controlled by the USPS or an official entity has no support in the specification. Clarification is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 157-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,005,945 to Harry T. Whitehouse in view of U.S. Patent No. 6,349,292 to Andrew V. Sutherland et al.

6. As per claims 157 and 160, Whitehouse clearly teaches a postage indicia generation system for implementation with a postal system, comprising;

- a centralized postage-issuing computer system accessible to a plurality of end user computers, configured to generate and transmit a unique postage indicium to an end user computer upon request by the end user computer to be applied to a mail piece (See Whitehouse figure 2, column 10, lines 20-29, column 15, lines 34-43, column 6, lines 30-65, and column 26, lines 49-55);
- a master tracking computer system, communicatively coupled to the centralized postage-issuing computer system, configured to generate a unique tracking identification string to be applied to the mail piece and to send the unique tracking identification string to the centralized postage-issuing

Art Unit: 3621

computer system (See Whitehouse column 6, lines 30-65, column 13, lines 15-65 and column 14, line 66- column 15, line 17),

- wherein the centralized postage-issuing computer system is further configured to associate the tracking identification string with the unique postage indicium and store the association in a database (See Whitehouse column 21, line 11-column 22, line 64).
- further wherein the centralized postage-issuing computer system enables a user to verify the unique postage indicium on the mail piece by sending the tracking identification string to the centralized postage-issuing computer system (See Whitehouse column 13, lines 19-55).
- wherein the unique tracking identification string on the mail piece is represented as a one-dimensional barcode, and wherein the centralized postage-issuing computer system enables a user to verify the unique postage indicium on the mail piece by submitting data derived from the one-dimensional barcode.

What is not clearly specified by the Whitehouse is the use of the unique serial number (tracking information or tracking identification string) to verify the postage indicia based on the detection of such tracking string from a one-dimensional bar-code (See Whitehouse column 10, lines 10- column 11, line 57, column 13, lines 16-60, column 14, line 66- column 15, line 43). However, Sutherland clearly teaches that the use of the one-dimensional bar-code as a way of reducing the number bits used in a indicia as well as the information in the bar-code for avoiding the use of two-dimensional bar-code required by the IBIP (See Sutherland figure 1 and associated text, column 2, lines 29-60 and column 7, line 1- column 8, line 68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Sutherland into that of Whitehouse to simplify and reduce the overhead information employed by the Whitehouse teachings and simplifying the validation of the postage indicia.

7. As per claims 158-159 and 161, Whitehouse clearly teaches a postage indicia generation system for implementation with a postal system of claims 157 and 160, further disclosing;

Art Unit: 3621

submission of a request for the verification of data derived from one dimensional barcode, and validation of indicia and signature derived from the information within the indicia (See White house column 13, lines 15-65 and column 17, line 60- column 18, line 11).

8. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Alternatively claims 157-161 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5917,925 to Lewis J. Moore.

11. As per claims 157 and 161, Moore clearly teaches a postage indicia generation system for implementation with a postal system, comprising;

- a centralized postage-issuing computer system accessible to a plurality of end user computers, configured to generate and transmit a unique postage indicium to an end user computer upon request

Art Unit: 3621

by the end user computer to be applied to a mail piece (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6);

- a master tracking computer system, communicatively coupled to the centralized postage-issuing computer system, configured to generate a unique tracking identification string to be applied to the mail piece and to send the unique tracking identification string to the centralized postage-issuing computer system (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6),
- wherein the centralized postage-issuing computer system is further configured to associate the tracking identification string with the unique postage indicium and store the association in a database. (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6),
- further wherein the centralized postage-issuing computer system enables a user to verify the unique postage indicium on the mail piece by sending the tracking identification string to the centralized postage-issuing computer system (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6);
- wherein the unique tracking identification string on the mail piece is represented as a one-dimensional barcode, and wherein the centralized postage-issuing computer system enables a user to verify the unique postage indicium on the mail piece by submitting data derived from the one-dimensional barcode (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59-

Art Unit: 3621

column 10, line 24, column 13, lines 4-29 and lines 56-63, column 15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6),

- the unique serial number (tracking information or tracking identification string) to verify the postage indicia based on the detection of such tracking string from a one-dimensional bar-code (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column 15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6).

12. As per claims 158-159 and 161, Whitehouse clearly teaches a postage indicia generation system for implementation with a postal system of claims 157 and 160, further disclosing;

submission of a request for the verification of data derived from one dimensional barcode, and validation of indicia and signature derived from the information within the indicia (See Moor abstract, column 3, line 56- column 9, line 20, column 20, line 59- column 10, line 24, column 13, lines 4-29 and lines 56-63, column 15, lines 20-36, column 16, lines 4-9 and line 66- column 17, lines 20, column 18, lines 2-8, column 24, lines 21- column 25, line 6).

13. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.



Art Unit: 3621

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Andrew Fischer** can be reached at **(571) 272-6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see;

**<http://portal.uspto.gov/external/portal/pair>**

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

Art Unit: 3621

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

**Knox Building, 50 Dulany St. Alexandria, VA.**

**Kambiz Abdi**  
Primary Examiner  
AU 3621

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.

**KAMBIZ ABDI**  
**PRIMARY EXAMINER**

**March 15, 2007**